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REMARKS

Applicant has considered and studied the Office Action dated January 31, 2006. Claims 1-22 are pending. Claims 1, 10 and 19 are independent claims. Claims 1-22 are rejected. It is respectfully submitted that the application is in condition for allowance.

§ 103 Rejections

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuster et al. ("Schuster" U.S. Pat. No. 6,937,699). Applicant respectfully disagrees with the Examiner's interpretation of Schuster and respectfully traverses the rejection.

Preliminary issues with regard to the rejections:

The following is asserted, at paragraph 5 on page 3 of the Office action:

Schuster "does not clearly teach the limitation 'determining status of each terminal based on call status information included in the call setup information exchanged between each terminal and the gateway system, transmitting the information to each terminal in an on-hook status thereof after checking the on-hook status of the terminal, and displaying the information on a display unit of the terminal' but it is suggested."

Schuster "does provide the environment wherein information is sent from an information server to a terminal which is capable of displaying the terminal regardless of the terminal being on-hook or off-hook," (emphasis added) specifically citing "col. 16, line 62 – col. 17, line 5.

Schuster "further provides an embodiment wherein a user is provided with a commercial message when connection is made to a telephony connection server in order to make a connection to another party and be in an 'off-hook' status," specifically citing col. 17, lines 27-39.

"it is taught by Schuster ... broadly to display information retrieved from an information server when in any condition" and that "the ability to display information when the user terminal is in an 'on-hook' condition is deemed an obvious variation of Schuster."

1. It is assumed that the Examiner meant to use the word "information" instead of the word "terminal" with respect to the assertion of "a terminal which is capable of displaying the terminal regardless of the terminal being on-hook or off-hook."
2. Applicant respectfully requests clarification of the Examiner's assertions with regard to Schuster given that the Examiner first asserts that "it is suggested" with regard to the limitations that the Examiner admits Schuster "does not clearly teach" and then asserts that the limitation is "taught broadly" but goes on to assert that the limitation "is deemed an obvious variation of Schuster."

Is the assertion is that Schuster teaches the limitations or is the assertion is that the limitations would require modification of the Schuster invention.

Portions of Schuster cited:

Col. 16, line 62 to col. 17, line 5:

The disclosure is that "commercial messages" that include "image and/or text data" is "transported to the data network telephones 208, 216 for display on the telephone display device 116" and that the "commercial messages are stored in the commercial message database 122 ... managed by the commercial message server 120."

Col. 17, ll. 27-39:

The disclosure is "[t]he telephony connection server 150 sends the request to the data network telephone 218 [of] User B" and "[a]fter the receipt of the request, the

telephony connection server 150 sends the connection information 270 to the commercial message server" with the "commercial message server 120 ... then ... sending User B's commercial messages."

Neither of the cited portions identifies any "on-hook" or "off-hook" status of the "telephones 206, 216" or suggests that the display of the "commercial messages" is "regardless of the terminal being on-hook or off-hook."

Portions of Schuster not cited make it clear that the display of the information is when a terminal is in the "off-hook" state:

Col. 3, line 64, to col. 4, line 11:

The disclosure is of an embodiment where "a request is sent to initiate a telephone call between a first network telephone and a second network telephone" and "at least one commercial message is sent to the first data network telephone ... displayed on the display screen of the first data network telephone."

The "first data network telephone" must be in an "off-hook" state in order to "initiate a telephone call" and, therefore, the disclosure of displaying "at least one commercial message" on the "display screen of the first data network telephone" is related to the display of information when a terminal is in the "off-hook" state.

Col. 4, ll. 12-21:

The disclosure is of an embodiment where "a communication is established with a telephone service provider" and "[a]t least one commercial message is then sent ... and the commercial message is displayed at the data network telephone."

Once "communication is established," the "data network telephone" is in an "off-hook" state and, therefore, the disclosure of "the commercial message is displayed at

the data network telephone" is related to the display of information when a terminal is in the "off-hook" state.

Col. 12, ll. 17-26:

The disclosure is of a "display data function 251" that displays "the name(s) and user identifier(s) of the other party(-ies) to the call, the status of the telephone call, billing information" and that "may also provide access to the display interface 262 for the display of commercial messages sent from the commercial message server 120."

Disclosure of "the name(s) and user identifier(s) of the other party(-ies) to the call, the status of the telephone call, billing information" implies that a call is in progress or, in other words, that "the display of commercial messages sent from the commercial message server 120" is related to the display of information when a terminal is in the "off-hook" state.

Col. 17, ll. 15-67:

The disclosure is, with respect to FIG. 3A, of a telephone call initiated "from User A's data network telephone 208 to the data network telephone 218 belonging to User B, whereby "User A begins the telephone call by dialing User B's user identifier" and "the merchant's commercial message 272 received from the commercial message server 120 ... is extracted from the message body of the response and displayed on the display 116."

The disclosure indicates "[t]he displayed commercial message 316 may include a display button 328" that "[w]hen pressed, the display button 328 initiates a speed dial connection 290, at the termination of the present telephone call" or "may also initiate the telephone call immediately because multiple communication channels may be established during a telephone call."

Disclosure of "display 116" on which "the merchant's commercial message 272 received from the commercial message server 120" is displayed is, per FIG. 3A, the display of "User A" and, since the telephone is initiated "from User A's data network telephone 208," User A is in an "off-hook" state and the disclosure is, therefore, related to the display of information when a terminal is in the "off-hook" state.

There is no disclosure of any display of "the merchant's commercial message 272 received from the commercial message server 120" on the display of User B.

Col. 18, line 14, to col. 20, line 29:

The disclosure is, with respect to FIGS. 3B, 4A and 4B, of alternate methods for displaying a commercial message that are disclosed with respect to the disclosure related to FIG. 3A and, therefore, also are related to the display of information when a terminal is in the "off-hook" state.

With respect to FIG. 4A, the disclosure is that "one advantage of the embodiment of FIG. 4A is that the communication of commercial messages may continue throughout the time of the telephone call, thereby further supporting that the disclosure is related to the display of information when a terminal is in the "off-hook" state.

Col. 20, line 30, to col. 21, line 42:

With respect to FIGS. 5A and 5B, the first disclosure of any display of the "commercial messages" to "User B's data network telephone 218" and it is disclosed "the telephony connection server 150 detects that User B's data network telephone 218 is a party (callee or caller) to the telephone connection."

The disclosure is "[f]or any of the embodiments in FIGS. 3-5, the connection information may also be communicated to the commercial message server 120 to signal

the end of the telephone call" so the "commercial message server 120 would then know to discontinue the communication of the commercial messages."

Once "User B's data network telephone 218 is a party (callee or caller) to the telephone connection," User B is "off-hook" and, therefore, the disclosure is related to the display of information when a terminal is in the "off-hook" state.

The disclosure that the "commercial message server 120 would then know to discontinue the communication of the commercial messages" when "the connection information [is] communicated ... to signal the end of the telephone call," implies that there is no "on-hook" display since there would no longer be any "commercial messages" communicated for display, thereby reinforcing that the disclosure is related to the display of information when a terminal is in the "off-hook" state.

Col. 21, line 49, to col. 23, line 20:

The disclosure is, with respect to FIGS. 6-8, of "methods for providing advertising services on a telephone" and it is disclosed that an "off-hook" status is established, by "determine[ing] the telephone calls that have been established" at "step 502" and "receiv[ing] information including the user identifiers of the parties" at "step 602," prior to any "advertisement services" provided "[a]t step 506" or any "commercial message is sent" to the data network telephone "[a]t step 606."

The establishment of an "off-hook" state prior to providing the "commercial message" or "advertisement services" results in any subsequent display of "commercial message" or "advertisement services" occurring when a terminal is in the "off-hook" state.

In view of the extensive disclosure in Schuster related to the display of information when a terminal is in the "off-hook" state, there is no suggestion, either

implicit or explicit, of displaying the information "regardless of the terminal being on-hook or off-hook," as asserted by the Examiner.

Further, "the ability to display information when the user terminal is in an 'on-hook' condition" would, therefore, also not be an "obvious variation of Schuster."

One "of ordinary skill in the art" would not be motivated by the teachings of Schuster to modify the Schuster invention as asserted without the benefit of impermissible hindsight bases upon the disclosure in the Applicant's specification.